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IN THE

Supreme Court of the United States

LIFE TECHNOLOGIES CORPORATION, ET AL.,

Petitioners,

—v.—

PROMEGA CORPORATION,

Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF *AMICUS CURIAE* OF INTELLECTUAL PROPERTY PROFESSORS IN SUPPORT OF PETITIONERS

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INTEREST OF THE *AMICI CURIAE*[1]

Amici are law professors who specialize in intellectual property law and who have previously published on, or have interest in, the issue of extraterritoriality. Amici have no personal stake in the outcome of this case but has an interest in seeing that the patent laws develop in a way that promotes rather than impedes innovation.

SUMMARY OF THE ARGUMENT

This Court has made clear that, absent a clear expression from Congress, U.S. laws do not apply extraterritorially. The Court has noted that the presumption against extraterritoriality has particular force in the context of patent law. The Federal Circuit has given short shrift to this argument. This case presents the opportunity for the Court to strike the appropriate extraterritorial reach for a U.S. patent under 35 U.S.C. § 271(f) and

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[1] Pursuant to Supreme Court Rule 37.6, *amici curiae* affirms that no counsel for a party authored this brief in whole or in part, that no counsel or a party made a monetary contribution intended to the preparation or submission of this brief and no person other than *amici curiae*, their members, or their counsels made a monetary contribution to its preparation or submission.

Respondent consented in writing to the filing of this brief, which is being filed with this brief. Petitioners filed blanket consent to the filing of amicus briefs, which is on file with the clerk.

to signal to the Federal Circuit to take the presumption against extraterritoriality seriously.

The brief offers two approaches to answer this question. The first, following the typical approach to extraterritoriality, argues that the Federal Circuit's interpretation was unnecessarily broad in light of the presumption. Second, the brief offers an alternative approach for patent law, drawing on academic literature, criminal law, and trademark law: courts should consider the potential for conflicts with foreign law in assessing whether liability for patent infringement is appropriate.

ARGUMENT

I. THE SUPREME COURT HAS CREATED A STRONG PRESUMPTION AGAINST THE EXTRATERRITORIAL APPLICATION OF UNITED STATES LAW, AND PARTICULARLY UNITED STATES PATENT LAW

The Supreme Court has established that there is a strong presumption against the extraterritorial application of U.S. law. *See, e.g., RJR Nabisco, Inc. v. European Cmty.*, 136 S. Ct. 2090, 2101, 2106 (2016) (finding presumption rebutted for § 1962 of Racketeer Influenced and Corrupt Organizations Act but not § 1964(c)); *Kiobel v. Royal Dutch Petroleum Co.*, 133 S. Ct. 1659, 1669 (2013) (relying on presumption to decline to extend reach of Alien Tort Statute); *Morrison v. Nat'l Australia Bank Ltd.*, 561

U.S. 247, 265 (2010) (relying on presumption to decline application of United States securities law to foreign conduct); *E.E.O.C. v. Arabian Am. Oil Co.*, 499 U.S. 244, 259 (1991) (using presumption to decline application of Title VII to employment practices of U.S. employers employing U.S. citizens abroad). Although Congress undisputedly has the authority to regulate acts outside of the territorial boundaries of the United States, the Court has recognized that "legislation of Congress, unless a contrary intent appears, is meant to apply only within the territorial jurisdiction of the United States . . . ." *Foley Bros. v. Filardo*, 336 U.S. 281, 285 (1949).

As this Court has noted, "[w]hen a statute gives no clear indication of an extraterritorial application, it has none." *Morrison v. Nat'l Australia Bank Ltd.*, 561 U.S. 247, 248 (2010). While falling short of a "clear statement rule," *see id.* at 265, *Morrison* emphasized the importance and power of the rule: "the presumption against extraterritorial application would be a craven watchdog indeed if it retreated to its kennel whenever *some* domestic activity is involved in the case." *Id.* at 266; *see also* Timothy R. Holbrook, *Should Foreign Patent Law Matter?*, 34 CAMPBELL L. REV. 581, 601-07 (2012) (discussing implications of *Morrison* for patent law).

This watchdog has particular bite in the context of patent law. *See Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 454-55 (2007) ("The presumption that United States law governs domestically but does not rule the world applies with particular force in patent law."). Indeed, as far back

as 1856, this Court rejected the extraterritorial reach of a patent: "The power thus granted is domestic in its character, and necessarily confined within the limits of the United States." *Brown v. Duchesne*, 60 U.S. 183, 195 (1856) (holding U.S. patent rights do not extend to invention on foreign vessel in U.S. port).

More recently, the Court again rejected a party's attempt to use its patent to control extraterritorial activity. In *Deepsouth Packing Co. v. Laitram Corp.*, the Supreme Court concluded that the manufacture of all components of a patented invention in the United States, that subsequently was assembled abroad, did not constitute infringement of a U.S. patent. 406 U.S. 518, 529 (1972). The Court emphasized that "[o]ur patent system makes no claim to extraterritorial effect." *Id.* at 531. Without a clear statement from Congress that the statute was meant to apply to activity outside of the territorial limits of the United States, the Supreme Court refused to grant the statute such an expansive scope.

Although Congress provided the "clear and certain" signal, abrogating *Deepsouth* in part by adopting 35 U.S.C. § 271(f) in 1984, the Supreme Court relied on the presumption against extraterritoriality to construe that provision narrowly. In *Microsoft Corp. v. AT&T Corp.*, the Court held (1) that only physically-embodied computer software, not software in the abstract, could constitute a "component" under § 271(f), 550 U.S. 437, 449-50 (2007), and (2) that such components were not "supplied" under § 271(f) when

copies of the software were made outside of the United States. *Id.* at 452-54. To support its interpretation, the Court specifically noted that "[a]ny doubt that Microsoft's conduct falls outside § 271(f)'s compass would be resolved by the presumption against extraterritoriality . . . ." *Id.* at 454. Notwithstanding that Congress explicitly abrogated *Deepsouth* to afford some extraterritorial protection to U.S. patent holders, the Court rejected AT&T's argument that the presumption was inapplicable and used the presumption to construe § 271(f) narrowly. *Id.* at 454-56. *See generally* Timothy R. Holbrook, *Extraterritoriality in U.S. Patent Law*, 49 WM. & MARY L. REV. 2119, 2135-36 (2008) [hereinafter *Extraterritoriality*] (discussing importance of the use of the presumption in *Microsoft*).

II. THE FEDERAL CIRCUIT CONSISTENTLY FAILS TO CONSIDER THE PRESUMPTION AGAINST EXTRATERRITORIALITY IN INTERPRETING THE PATENT LAWS.

Notwithstanding the clear message from the Supreme Court regarding the presumption against the extraterritorial application of U.S. law – and patent law in particular – the Federal Circuit has consistently failed to give the presumption its due weight. This case is but one of many that exemplifies this failure. As such, this case presents more than the opportunity to answer the relatively narrow question before it; it also affords the Court

the chance to speak to the Federal Circuit about the importance of applying the presumption appropriately even beyond this case.

A. In Various Other Cases, the Federal Circuit Has Given the Presumption Against Extraterritoriality Short Shrift.

Notwithstanding the Court's clear statement that the presumption against the extraterritorial application of United States law has "particular force in patent law," *Microsoft*, 550 U.S. at 455, the Federal Circuit's application of the presumption has been, at best, inconsistent. *See generally* Holbrook, *Extraterritoriality*, *supra* at 2136-54. Generally, the court has been willing to afford extraterritorial protection to U.S. patent holders while rarely affording the presumption much weight.

For example, in *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Contractors USA, Inc.*, 617 F.3d 1296 (Fed. Cir. 2010), the Federal Circuit held that there was an infringing offer to sell an invention if the sale contemplated in the offer was to be in the United States, even though all negotiations took place outside of the United States. *Id.* at 1309. As a result of this holding, a party can be liable for patent infringement in the United States notwithstanding that there has never been any activity within the United States. Timothy R. Holbrook, *Territoriality and Tangibility After* Transocean, 61 EMORY L.J. 1087, 1112 (2011) [hereinafter *Territoriality*]. While the Federal Circuit acknowledged the presumption, it failed to

account for the broad extraterritorial reach its decision afforded to United States patents. When Maersk filed a petition for a writ of certiorari, the Supreme Court asked for the Solicitor General's views on the case, but the case ultimately settled.[2]

The Federal Circuit similarly has afforded extraterritorial protection for the use of systems that straddle national borders. In *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282 (Fed. Cir. 2005), the court found infringement of a mobile email system where part of the system – the relay – was located in Canada. *Id.* at 1317. The court concluded that, while part of the system was outside of the United States, the use of the system was within the United States because the users controlled the devices and obtained the benefit of the system – receipt of email – in the United States. *Id.* at 1316-17. At no point did the court mention the presumption against extraterritoriality in affording this protection.

Finally, in interpreting the provision at issue in this case, 35 U.S.C. § 271(f), the Federal Circuit generally has been expansive in its interpretation. For example, the Federal Circuit has held that there is infringement under § 271(f) even if the device is never assembled outside of the United States. *Waymark Corp. v. Porta Sys. Corp.*, 245 F.3d 1364,

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[2] Subsequently, the Federal Circuit has held that there is no infringement when the offer takes place in the United States but the contemplated sale is to occur outside of the United States. *See* Halo Elecs., Inc. v. Pulse Elecs., Inc., 769 F.3d 1371, 1381 (Fed. Cir. 2014), *vacated and remanded on other grounds*, 136 S. Ct. 1923 (2016).

1368 (Fed. Cir. 2001). This interpretation expands the scope of this provision by ensnaring conduct abroad regardless of whether anyone has has assembled the device. Oddly the Federal Circuit suggested this interpretation avoided the appearance of providing extraterritorial reach to United States, *id.*, yet the court's decision actually expanded such reach.

The Federal Circuit also held that a "component" under § 271(f) could be an intangible item such as software, *Eolas Techs. Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1339 (Fed. Cir. 2005), and that supplying the component included software replicated abroad from a master version, *AT&T Corp. v. Microsoft Corp.*, 414 F.3d 1366, 1370 (Fed. Cir. 2005), *rev'd*, 550 U.S. 437 (2007). The Supreme Court rejected in part these expansive interpretations of the statute in *Microsoft Corp. v. AT&T Corp.*, *see* 550 U.S. at 451-54, but these cases again show that the Federal Circuit consistently provides § 271(f) an expansive interpretation while failing to give proper account of the presumption against extraterritoriality.[3]

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[3] The Federal Circuit has provided a narrow interpretation of § 271(f), concluding it does not apply to patented methods or processes. *See* Cardiac Pacemakers, Inc. v. St. Jude Med., Inc., 576 F.3d 1348, 1359 (Fed. Cir. 2009) (en banc in relevant part). The Federal Circuit in *Cardiac Pacemaker* did rely on the presumption to afford § 271(f) a narrow interpretation. *See id.* at 1365 ("Any ambiguity as to Congress's intent in enacting Section 271(f) is further resolved by the presumption against extraterritoriality."). It is not clear, however, that this

Such failure to accord the presumption appropriate consideration lead to the flawed construction in this case and has also resulted in questionable interpretations of other provisions. The Court should take the opportunity here to emphasize the broad reach of the presumption against extraterritorial application of U.S. patents.

B. Appropriate Consideration of the Presumption Should Lead to a Narrower Construction Here: A Single Component Cannot Be a "Substantial Portion" of the Claimed Invention.

The Federal Circuit has a penchant for providing extraterritorial protection for U.S. patent holders without giving appropriate consideration to the presumption against such reach, particularly in patent law. This case is consistent with the Federal Circuit's failure to take the presumption seriously.

Here, the Federal Circuit majority never even mentioned the presumption, let alone assessed whether it had been rebutted.[4] There is not a single

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provision should not apply to method claims. *See* Timothy R. Holbrook, *Method Patent Exceptionalism*, 102 IOWA L. REV. (forthcoming 2017) (manuscript at 29-31), papers.ssrn.com/sol3/papers.cfm?abstract_id=2760490.

[4] In her dissent, Chief Judge Prost noted that "the Supreme Court has cautioned against employing a policy-oriented approach to judicial decision making when it would cause law to have extraterritorial application," thus alluding to the

citation to *Morrison* or *Kiobel*, the Supreme Court's most recent cases discussing the presumption.

Unsurprisingly, the interpretation of § 271(f) provided by the Federal Circuit at issue before this Court expanded that provision's extraterritorial reach. By holding that "all or a substantial portion of the components of a patented invention" can include a *single component*, *Promega Corp. v. Life Techs. Corp.*, 773 F.3d 1338, 1353 (Fed. Cir. 2014), the court expanded the set of activities that can trigger liability for events occurring outside of the United States. Now, sending a single component can constitute a violation of § 271(f), as opposed to requiring all or nearly all of the components of a patented invention. The latter approach would dramatically curtail the extraterritorial reach of this provision.

As the provision most directly related to *Deepsouth*, it is clear that § 271(f) is meant to deal with multiple components being shipped abroad, and the "substantial portion" was to combat potential gaming of the statutory regime by sending *nearly* all of the components. In that context, the extraterritorial scope is fairly circumscribed and limited to address the situation in *Deepsouth*. The Federal Circuit's interpretation disrupts such proportionality.

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presumption. *Promega Corp. v. Life Techs. Corp.*, 773 F.3d 1338, 1360 (Fed. Cir. 2014) (Prost, C.J., dissenting-in-part).

Moreover, the court's interpretation renders § 271(f)(2) superfluous and removes that provision's important safety valve. Section 271(f)(2) explicitly addresses the exportation of a single component that is to be combined abroad in a device that would be infringing if in the United States. Specifically, it provides:

> (2) Whoever without authority supplies or causes to be supplied in or from the United States *any component* of a patented invention that is especially made or especially adapted for use in the invention and *not a staple article or commodity of commerce suitable for substantial noninfringing use*, where such component is uncombined in whole or in part, knowing that such component is so made or adapted and intending that such component will be combined outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

35 U.S.C. § 271(f)(2) (2013) (emphasis added).

Importantly, Congress recognized the potential broad scope of such a provision and carefully limited it to components that have no substantial non-infringing use. 35 U.S.C. § 271(f)(2). This safe harbor is an important safety valve to avoid triggering liability against persons who are simply selling a staple article that happens to end up

in what would be an infringing good if combined in the United States.

Section 271(f)(1) in contrast has no such safe harbor. By allowing a single component to satisfy the requirement of "all or a substantial portion of the components of a patented invention," it renders § 271(f)(2) superfluous. More troubling, it removes § 271(f)(2)'s important safe harbor, allowing someone to be liable for exporting a staple article of commerce, i.e. something that has substantial non-infringing uses.

The facts of this case demonstrate that problem. The component exported by Life Technologies, the accused infringer in this case, is *Taq* polymerase, which is a staple for any polymerase chase reaction (PCR) for amplifying any DNA sample beyond the particular use in this case. *See* National Center for Biotechnology Information, *PCR*, http://www.ncbi.nlm.nih.gov/genome/probe/doc/TechPCR.shtml (last visited Aug. 1, 2016). As such, although there would not be liability under § 271(f)(2) due to the substantial non-infringing uses of *Taq* polymerase, there is now liability under § 271(f)(1).

This expansive interpretation runs counter to the presumption against the extraterritorial application of U.S. patents. The more appropriate interpretation is to limit § 271(f)(1) to multiple components and leave § 271(f)(2) – with its important safety valve – to govern the exportation of single components.

III. AN ALTERNATIVE APPROACH TO EXTRATERRITORIALITY IN PATENT LAW: ACTUAL CONSIDERATION OF POTENTIAL CONFLICTS WITH A RELEVANT FOREIGN COUNTRY'S PATENT LAWS

In the era of the Internet, systems that straddle national borders, and increasing global trade, our territorially-rooted patent system faces new pressures, requiring a systemic reevaluation of the territorial nature of U.S. patent rights. Permitting certain extraterritorial protection for patents enhances their value.

Counter to the typical view of Congress's relationship with the courts, in this context, Congress lacks the dexterity to react to an ever-changing marketplace of new technologies. Instead, the courts are in the best position to address these concerns. Under this proposal, courts should explicitly consider foreign patent laws to determine whether the enforcement of the U.S. patent would create a conflict with the foreign law. This approach ties the enforceability of a U.S. patent right to the availability of that right in a foreign country. If there is a conflict, then the patent holder could not seek any extraterritorial relief.

This Court should embrace a formal consideration of the law of the relevant country to determine whether a conflict of laws actually exists. Allowing limited extraterritorial protection, but only absent an actual conflict, allows a patent holder to

coordinate activities through the use of fewer domestic rights, mitigating the need to assemble a portfolio of national rights from a variety of countries. Given the increasingly international nature of global trade, such flexibility would benefit U.S. patent holders. *See generally* Holbrook, *Extraterritoriality*, *supra* at 2163-85 (articulating a methodology for considering foreign patent law for purposes of extraterritorial application of a U.S. patent).

A. Due to the Various International Treaties, Patent Laws Across the World Have Very Similar Concepts, Making Consideration of Foreign Law Feasible.

One of the justifications for the presumption against extraterritoriality is to avoid potential conflicts with the laws of other sovereign nations. *See RJR Nabisco,* 136 S. Ct. at 2100 ("Most notably, it serves to avoid the international discord that can result when U.S. law is applied to conduct in foreign countries."). Nevertheless, the Court has made clear that the presumption applies regardless of whether there is such a conflict. *Morrison*, 561 U.S. at 255 ("The canon or presumption applies regardless of whether there is a risk of conflict between the American statute and a foreign law.") (citation omitted). In general, such a failure to consider the potential conflict of laws may be appropriate because the laws of different countries may differ significantly. Such analysis could prove challenging to courts.

That is not the case with patent law, however. Under the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), members of the World Trade Organization (WTO) are obligated to have patent systems that contain certain minimum requirements. For example, WTO members can only grant patents on inventions that are novel, have an inventive step (i.e. are non-obvious), and are adequately disclosed. TRIPS arts. 27 & 29. Although there is some variance across the globe, TRIPS has ensured that many of the fundamental concepts that underlie patent protection reach a certain level of coherence across countries.

Moreover, given the coordination of patent applications through the Patent Cooperation Treaty (PCT) process, patents often are very similar in form from country to country. *See* PCT, June 19, 1970, 28 U.S.T. 7645, *available at* http://www.wipo.int/treaties/en/registration/pct/. As a result, U.S. courts have a basic familiarity with the concepts of patent law that transcends territorial borders. Considering potential conflicts, therefore, is less problematic in the patent context because the laws and concepts underlying foreign patent law will be similar to those confronted by U.S. courts.

Despite possible remaining concerns with the institutional competence of courts to address foreign law, even with this level of harmonization, the interests of each party greatly mitigate these concerns. Both parties to the litigation have strong

incentives to educate the court as to the relevant foreign law. The accused infringer necessarily is active in the foreign country at issue and thus should have some familiarity with the law there. By comparison, the U.S. patent holder may be at a disadvantage because proving an infringement case would be more difficult. However, the extraterritorial application of a U.S. patent should be exceptional in nature. The U.S. patent holder's pragmatic disadvantage should be of no concern because the patent holder is seeking the exceptional remedy of extraterritorial protection. *See* Holbrook, *Extraterritoriality*, at 2127–28.

B. Express Consideration of Foreign Law by U.S. Courts Is Not Unprecedented.

Although it may seem odd to ask U.S. courts to consider foreign law in this fashion, courts do consider foreign law along these lines in at least two other contexts: criminal extraditions and trademark law.

1. A Country Seeking Extradition of an Individual Must Demonstrate that Asserted Activity Was a Crime in Both Countries.

In the criminal law context, a country seeking extradition of a person residing in another country must demonstrate that the accused behavior is

criminal in both countries. According to the Restatement (Third) of Foreign Relations Law:

> Under most international agreements, state laws, and state practice:
>
> (1) A person sought for prosecution or for enforcement of a sentence will not be extradited
>
> ***
>
> (c) if the offense with which he is charged or of which he has been convicted is not punishable as a serious crime in both the requesting and the requested state . . . .

Restatement (Third) of Foreign Relations Law § 476(1)(c) (1987). This dual-criminality principle requires that the activities of the accused constitute a crime in both jurisdictions for extradition to be appropriate, even if the acts occurred only in one of the countries. In this context, a U.S. court would need to consider both U.S. law and foreign law to determine whether extradition is appropriate.

The proposal here operates similarly. The patent holder would have to demonstrate that there would be infringement in the U.S. and infringement in the foreign country. If there were some sort of conflict – such as, for example, a different owner of the foreign patent or a licensee defense in the foreign

jurisdiction – then there would be no liability under the U.S. patent.

2. The Supreme Court Has Expressly Considered Conflicts in the Context of Federal Trademark Law

Courts also expressly consider foreign law in the trademark context, following the Court's decision in *Steele v. Bulova Watch Co.*, 344 U.S. 280 (1952). In *Bulova*, the accused trademark infringer was a U.S. citizen selling arguably infringing counterfeit watches in Mexico. *Id.* at 281. At one point, the accused had a trademark registration in Mexico for the mark BULOVA, but the Mexican government had revoked it. *Id.* Some of the infringing watches managed to make their way back into the United States, particularly along the Texas-Mexico border. *Id.*

The issue was whether U.S. courts had jurisdiction to hear a claim of trademark infringement under U.S. law when the allegedly infringing acts took place entirely in Mexico. The Supreme Court held that, under these facts, jurisdiction was appropriate. *Id.*

Although the courts of appeals have differed in their applications of *Bulova*, all of their formulations include consideration of a potential conflict with foreign law. For example, the Second Circuit considers three factors in assessing whether to apply trademark law extraterritorially: (1) whether there is a substantial effect on U.S.

commerce; (2) what the citizenship of the accused infringer is; and (3) whether there would be a conflict with foreign law. *Vanity Fair Mills, Inc. v. T. Eaton Co.*, 234 F.2d 633, 642 (2d Cir. 1956). The First Circuit has taken a slightly different approach: "we disaggregate the elements of its test: we first ask whether the defendant is an American citizen, and if he is not, then we use the substantial effects test as the sole touchstone to determine jurisdiction." *McBee v. Delica Co.*, 417 F.3d 107, 121 (1st Cir. 2005). The court then moves to consider comity and potential conflicts as a prudential question. *Id.*

The Ninth Circuit recently revisited the issue of extraterritoriality in the trademark law context, considering the impact of *RJR Nabisco.* Applying the two-step framework of *RJR Nabisco*, the Ninth Circuit concluded that, under *Bulova*, the Lanham Act (the federal trademark statute) has extraterritorial reach. *Trader Joe's Co. v. Hallatt*, No. 14-35035, 2016 WL 4488009, at *3 (9th Cir. Aug. 26, 2016). In assessing whether such protection was appropriate, however, the court expressly considered seven comity factors, including conflicts with foreign law. *Id.* at **8-11.

In all permutations, the courts of appeals expressly consider potential conflicts with foreign law. Holbrook, *Territoriality,* at 1121 n.144. The express consideration of foreign law and potential conflicts, therefore, is not unprecedented.

3. Commentators Have Argued for Consideration of Potential Conflicts in Intellectual Property Law

Commentators have also suggested looking at foreign law to assess the extraterritorial reach of patent law and other forms of intellectual property laws. *See, e.g.*, Holbrook, *Extraterritoriality*, *supra* at 2163-83; Melissa Feeney Wasserman, Note, *Divided Infringement: Expanding the Extraterritorial Scope of Patent Law*, 82 N.Y.U. L. REV. 281, 304 (2007) (arguing for use of six comity factors to balance concerns of extraterritorial reach of U.S. patents); *see also* Graeme B. Dinwoodie, *A New Copyright Order: Why National Courts Should Create Global Norms*, 149 U. PA. L. REV. 469, 542-43 (2000) ("[A] court faced with an international copyright dispute would not necessarily apply the copyright law of a single state . . . . Instead, it would consider whether the international dimension implicated policies of other states or the international copyright system, and develop (and apply) a substantive rule of copyright law that best effectuates this range of policies.").

These commentators all recognize that our systems for generating innovation and creativity are no longer truly domestic. Instead, all intellectual property laws now have international aspects to them. Ignoring this dynamic inappropriately discounts the manner in which the various incentives of patents operate around the world.

C. Expressly Considering Foreign Patent Law Leads to Many Laudable Benefits.

With international trade and interlocking patent law regimes, an approach which considers the potential conflicts with relevant foreign laws would afford a number of advantages. A consideration of foreign law by U.S. courts would facilitate a dialogue between U.S. courts and foreign jurisdictions, particularly between the Federal Circuit and other specialized patent courts.

Indeed, countries can act as individual laboratories, creating a variety of solutions to different innovation policy issues. One of these countries may find the optimal answer. Requiring courts to consider those differences may help improve our own laws. By analyzing the foreign law, judges can reach a greater understanding of the various intellectual property norms that exist in the world, and indeed may be able to identify situations where these norms have converged into an international standard.

Beyond recognizing extant norms, the dialogue could help foment such norms. Given the generally slow process of treaty negotiations and their inability to adapt to ever-evolving technologies, a judicial colloquy on patent law could help establish international norms that might reduce the transaction costs for international actors. This private law lever could act as an important and powerful supplement to the public law mechanisms.

Additionally, this analysis may serve to highlight important differences that exist among countries. Patent laws can reflect important social differences among countries, and those differences deserve respect and deference, just as the United States would expect respect and deference to its laws if applied by a foreign tribunal. The proposed methodology could also serve to identify such points of disagreement between countries which may form the basis for future political negotiations.

This dialogue may benefit Congress and other political bodies in addition to the courts. The decisions by U.S. courts may provide reasoning that would help Congress assess whether to amend the Patent Act, particularly if Congress is attempting to implement legislation in the name of harmonization. A court's reasoned analysis about the manner in which foreign jurisdictions deal with various patent issues would be a useful source of information for legislators who are attempting to fine tune, if not completely overhaul, U.S. patent law. *See generally* Holbrook, *Extraterritoriality*, *supra* at 2185-88.

CONCLUSION

The Supreme Court has repeatedly emphasized the importance of the presumption against the extraterritorial application of United States laws, a presumption that the Federal Circuit ignored in this case and generally fails to consider consistently and appropriately. If the Court follows its traditional methodology, then the lessons of *RJR Nabisco*,

Kiobel, and *Morrison* suggest that the Federal Circuit's interpretation of § 271(f)(1) is incorrect.

Nevertheless, this case also provides an opportunity for the Court to reconcile its patent jurisprudence with that of trademark law. The Court should embrace the formal consideration of conflicts with foreign law. Such consideration will facilitate transnational dialogue among courts and other innovation policymakers in a way that is more facile than legislation or treaty making.

Under either methodology, the case should be remanded to the Federal Circuit or District Court for a proper assessment of infringement under this provision.

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